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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. ALEXANDER MARCHOSKY

Appeal 2008-006234
Application 10/071,490
Technology Center 1600

Decided: August 20, 2009

Before RICHARD M. LEBOVITZ, FRANCISCO C. PRATS, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellant requests a rehearing under 37 C.F.R. § 41.52(a)(1) of our Decision entered January 23, 2009 (“Decision”) in which the written description rejection of claims 97, 98, and 103-108 was affirmed.

Statement of the case

The appealed claims are directed to a composition for promoting the growth and strengthening of bone “consisting essentially of” hyaluronic acid or a salt of it (“HA”), cancellous bone (“CB”), demineralized bone matrix (“DBM”), and non-decalcified bone matrix (“NDM”). Each component is present in a specifically recited amount. Claim 104 was selected as representative of the claimed subject matter.

The Patent Examiner had rejected the claims under 35 U.S.C. § 112, first paragraph, for lack of written description. The Examiner took the position that the claimed four-component composition “consisting essentially” of HA, CB, DBM, and NBM in the recited amounts “was not envisioned at filing” (Ans. 5). The Examiner explained:

While the specification . . . supports the general composition of claim 104, the specific composition limited by the consisting essentially of now recited in claim 104 is not envisioned. The specific composition having the specific ranges as stated in the claims additionally with the consisting essentially of was not envisioned at filing. There is nothing in the specification pointing to this specific combination of components and amounts. Most of the disclosure includes growth factors.

(*Id.*)

The Examiner’s rejection was affirmed because there was insufficient evidence to establish that the inventor invented the claimed four-component composition. To satisfy the written description requirement, the Specification must convey to persons of ordinary skill in the art that the inventor was in possession of the claimed invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). In this case, the Specification described a three-component composition of HA, CB, and

DBM in the *Summary of the Invention* and claimed it (FF1). However, we found:

[T]here is no explicit statement in the written description that the inventor invented this same composition with NBM.

Appellant provides a reason as to why NBM might be added to the three-component composition: because the Specification is said to teach that the combination of NBM and DBM is an alternative for DBM, alone (FF4; App. Br. 18). However, this was stated in the context of describing an osteoinductive material (FF3). There is no statement in the Specification that this substitution should be made in a different composition having only HA, CB, and DBM (FF1).

(Decision 7.)

Statement of the issues

Appellant seeks rehearing on the grounds that the Board overlooked the legal standard for written description under § 112, first paragraph and raised new grounds of rejection.

Analysis

Legal standard for Written Description

In affirming the Examiner's written description rejection, we cited the following legal principles as guidance:

To satisfy the written description requirement, the inventor "must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). In describing the claimed invention, there is no requirement that the wording be identical to that used in the specification as long as there is sufficient disclosure to show one of skill in the art that the inventor "invented what is claimed." *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000).

An applicant complies with the written description requirement “by describing the invention, with all its claimed limitations.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

(Decision 3.)

On page 17 of the Appeal Brief, Appellant stated:

To comply with the written description requirement, “the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question.” *Fujikawa v. Wattanasin*, 93 F.3d 1559 (Fed. Cir. 1996) at p. 1570. Finding the same wording (*ipsis verbis*) used in the claim is not necessary. *Id.* Thus, so long as a person “of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.” *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996) at p.1175. “. . . [H]ow the specification accomplishes this is not material.” *Id.* At p. 1172 (citing *In re Wertheim*, 541 F.2d 257,262 (C.C.P.A. 1976).”

As indicated by these passages, both the Board and Appellant recognized it is unnecessary to use the same words in the claim that appear in the Specification to comply with the written description requirement as long as the Specification reasonably conveyed “possession” of the claimed invention. Thus, it does not appear that our statement of the law conflicted with Appellant’s.

Appellant faulted our Decision for stating “[t]here is no word-for-word description of a composition consisting essentially of: 1) HA, 2) CB, 3) DBM, and 4) NBM as required by claim 104.” (Decision 6.) Based on this statement, Appellant concluded we had misapplied the law. Appellant stated: “Because there is no requirement for a word-for-word description of

any claim, the Board based its decision on an erroneous standard . . . ” (Req. Reh’g 3).

We did not misapprehend the written description standard. As evidenced by the Principles of Law section set forth in the Decision, we correctly understood that “there is no requirement that the wording be identical to that used in the specification as long as there is sufficient disclosure to show one of skill in the art that the inventor ‘invented what is claimed.’ *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000).” (Decision 3.)

Legal decisions are crafted after the decision-maker has made a careful inquiry into the facts of the case and then applied the relevant principles of law to the specific facts. Our statement about the absence of a “word-for-word description” of claim 104 in the Specification was a fact. It was specifically designated as Finding of Fact 6 in the section titled “Findings of Fact.” There was no reason to confuse it as anything other than a fact. Appellant has not even disputed the validity of this fact. Given the absence of a word-for-word description in the Specification of the later claimed subject matter of claim 104, we were compelled to consider whether the Specification in other ways “convey[ed] to persons of ordinary skill in the art that the inventor was in possession of the claimed invention.” (Decision 7.) Appellant has not identified a defect in how we applied the law to the facts.

New grounds of rejection

Appellant contends that a new ground of rejection was stated because the Board “raise[d] for the first time an artificial distinction between a three-

and four-component composition in finding inadequate support in the specification for claim 104.” (Req. Reh’g 3.)

Reference to the Specification disclosure of three and four component compositions was made in the Finding of Fact section of the Decision (FF1,¹ 2, 5, & 6). We explained in the Decision why the claimed four component composition “consisting essentially” of 1) HA, 2) CB, 3) DBM, and 4) NBM was not supported by the as-filed Specification. Our discussion did not constitute a new ground of rejection. The rejection was the same. We merely elaborated on the Examiner’s explanation. As held in *Hyatt v. Doll*, 2007-1066 (Fed. Cir. decided Aug. 11, 2009): “The Board cannot be said to have presented a new ground of rejection simply by elaborating on the examiner’s rejection or by using different words.”

Appellant also stated that we erred because “the Board’s own findings of fact describe compositions that include four components.” (Req. Reh’g 3-4.) Apparently, Appellant was referring to Findings 2 and 3, which are reproduced below for clarity:

2. A composition is described in the *Summary of the Invention* having an osteoinductive material (b) that comprises: 1) DBM, 2) NBM, and 3) “with or without” HA (Spec. 4:9-10; 5:7-9).

This composition is also described on page 16, lines 6-9, of the Specification (*see FF4 below*).

3. In addition to DBM, NBM, and HA, the composition (FF2) can comprise CB (Spec. 4:12) and growth factors (*id.* at 4:1-9).

A composition is described in the Summary of the Invention as “comprising” materials (a), (b), (c), and (d) (Spec. 4:1-20). Material (a)

¹ The Findings of Fact (“FF”) appear in our original Decision.

comprised growth factors. Finding of Fact 3 referred to the growth factors in material (a) and referenced it on page 4, lines 1-9 of the Specification. Material (b), an osteoinductive material comprising DBM, NBM, and HA, was summarized in Finding of Fact 2. Material (c) was to scaffolding material selected from a group that contained CA. Finding of Fact 3 referred to the CA in material (c) and referenced it on page 4, line 12 of the Specification.

Based on the evidence above, we do not dispute that the Specification described a composition comprising material (b) (DBM, NBM, HA), the growth factors of component (a), CB of material (c), as well as other ingredients. *See FF3*, referencing the “composition” described in the Summary of the Invention as containing other ingredients in addition to DBM, NDM, and HA. However, claim 104 does not recite the term “comprising,” but rather uses the phrase “consisting essentially of” which, as pointed out by the Examiner, would exclude growth factors (Ans. 5).² Therefore, while the Specification described compositions *comprising* HA, CB, DBM, NBM, and growth factors, there is no indication from the Specification that the inventors had conceived of a composition which contained HA, CB, DBM, and NBM, but lacked growth factors.

The Specification also described and claimed a composition for promoting growth and strengthening of bone that comprised: 1) HA, 2) CB,

² “Consisting essentially” excludes ingredients that do not materially affect the basic and novel properties of the claimed invention.” *PPG Industries Inc. v. Guardian Industries Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998) (referenced in the Decision on page 3). Appellant did not dispute the Examiner’s finding in the Answer that “consisting essentially of” would exclude growth factors.

and, 3) DBM (Spec. 5:27 to Spec. 6:3; Spec. 43; claim 56; FF1). This composition is different from the materials (a) through (d) described on pages 4-5 of the Specification and discussed above. Appellant stated that NBM could be added to it as an alternative for DBM, alone (FF4; App. Br. 18). However, as stated in the Decision, the substitution was described in the Specification “in the context of describing an osteoinductive material.” (Decision 7.) There was no statement in the Specification that this substitution should be made in the bone growth and strengthening composition having only HA, CB, and DBM (Decision 7; *see* FF4).

Based on Appellant’s analysis, we concluded that Appellant had invoked an improper standard for complying with the written description requirement for a claim which was not disclosed in the original application - as is the case here. “The question is not whether the Specification provides a *reason* to have made the invention which is now claimed, but whether the invention, with all its claimed limitations, is described in it. *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (1997).” (Decision 7-8.) As subsequently stated by the Federal Circuit, the written description “need not recite the claimed invention in *haec verba* but [it] must do more than merely disclose that which would render the claimed invention obvious.” *ICU Medical, Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009).

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Conclusion of Law

We have considered Appellant's Request for Rehearing, but decline to modify our original Decision entered January 23, 2009. The rehearing is

DENIED

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